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Section II. (Remarks)RECEIVED
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A. Response to Objection Under 35 USC § 132(a) and Claim Rejections Under 35 USC 112, First Paragraph

In the February 20, 2007 Office Action, the material added to page 8, second full paragraph of the specification by the amendment dated August 11, 2006 was objected to under 35 U.S.C. 132(a) as allegedly introducing new matter into the disclosure. In particular, the Examiner stated:

The added material which is not supported by the original disclosure is as follows:

Page 8, second full paragraph.

'Furthermore, relative to a central longitudinal axis extending through the closed distal end 14 and the proximal end 20, the open proximal end 20 has a cross-sectional area (in a direction perpendicular to the central axis) at least as large as the average cross-sectional area of the centrifuge tube 10.'

(February 20, 2007 Office Action, page 2.) Regarding the alleged "new matter," the examiner stated that "Applicant is required to cancel the new matter in the reply to this Office Action."

In a related fashion, claims 31-38 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the examiner alleged that:

"[n]othing in the original specification describes the centrifuge tube of body with an average cross-sectional area in a direction perpendicular to the central axis, and the open proximal end has a cross-sectional area at least as large as the average cross-sectional area."

(February 20, 2007 Office Action, page 2.)

The Examiner's conclusions in this regard are based on a myopic understanding of the present application and lack legal basis, as detailed below.

1. The Examiner Has Impermissibly Ignored the Drawings Considered With the Specification Text as Bases for Disclosure of the Relative Cross-Sectional Area Limitation

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It is well settled that the specification of a patent application includes the drawings,¹ and that drawings may be relied upon to satisfy the disclosure requirements of 35 U.S.C. §112.² As noted by the predecessor court to the Federal Circuit, **whatever is disclosed by the drawings “may be added to the specification in words without violation of the statute and rule [35 U.S.C. 132, Rule 118] which prohibit new matter.”** *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537, 542 (C.C.P.A. 1962).³ The Federal Circuit recognizes that “under proper circumstances, **“drawings alone may provide a ‘written description’ of an invention as required by § 112.”** *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

The test for determining compliance with the written description requirement [of 35 U.S.C. 112, first paragraph] is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, *rather than* the presence or absence of literal support in the specification for the claim language. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *In re Edwards*, 558 F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979). Drawings constitute an adequate written description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed.” *Cooper Cameron Corp. v. Kvaerner Oilfield Prods.*, 291 F.3d 1317, 62 USPQ2d 1846, 1850 (Fed. Cir. 2002).⁴

¹ See, e.g., *In re Hopkins*, 145 USPQ 140 (C.C.P.A. 1965)(Drawings are considered as part of patent disclosure). See also George Ticknor Curtis, *Law of Patents for Useful Inventions* 315-16 (4th Ed. 1873): “It has been settled, that the drawings constitute a part of the specification, when annexed thereto, and may be used to explain or help out the otherwise imperfect description in the specification. So that it is not necessary that the description should be wholly in writing, but it may be partly in writing and partly in drawing; and if by comparison of the words and the drawings, but one will explain the other sufficiently to enable a skillful mechanic to perform the work, and to show what is the invention claimed, the specification will be sufficient.”

² *Ex parte Horton*, 226 USPQ 697, 699 (Bd. Pat. App. & Int. 1985), citing: *In re Berkman*, 642 F.2d 427, 209 USPQ 45 (C.C.P.A. 1981); *Breen v. Cobb*, 487 F.2d 558, 179 USPQ 733 (C.C.P.A. 1973); *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (C.C.P.A. 1971); and *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (C.C.P.A. 1962).

³ See also *In re Heinle*, 145 USPQ 131, 136 (C.C.P.A. 1965)(Drawings and specification may be amended to conform to each other; added matter is not technical “new matter” within prohibition of 35 U.S.C. 132).

⁴ See also *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); *re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977)(The content of the drawings may also be considered in determining compliance with the written description requirement).

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The predecessor court to the Federal Circuit further reaffirmed the idea that **claims do not need to be limited to exact language of the specification**. See *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976) (“If lack of literal support alone were enough to support a rejection under § 112, then the statement of *In re Lukach*, 58 CCPA at 1235, 442 F.2d at 969, 169 USPQ at 796, that ‘the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of § 112,’ is empty verbiage. The burden of showing that the claimed invention is not described in the specification rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.”)

The *Wolfensberger* case, *supra*, is highly relevant and analogous to the present circumstances. In *Wolfensberger*, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board of Patent Appeals and Interferences rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a “packing ring” in “untensioned relationship” that included a “mean diameter corresponding approximately to the mean diameter of said chamber.” The CCPA held that Figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber. *In re Wolfensberger*, 302 F.2d 950, 133 USPQ 537, 541 (CCPA 1962). On the basis of disclosure supplied only by Figure 5, the court held that the application satisfied the written description requirement.

The instant application includes Figures 1-12. **It is noted that FIGS. 6-7 each illustrate a central longitudinal axis extending through the closed distal end and the open proximal end. It is further noted that any body inherently has a cross-sectional area.** These facts leave the only point of contention as whether the cross-sectional area of the open proximal end is larger than that of the average cross-sectional area of the tube.

FIGS. 1-7 show alternating views of centrifuge tubes having integral hinge elements. In FIGS. 1, 3, 5, and 6, the hinge elements are illustrated as aligned parallel with the drawing page, whereas in FIGS. 2, 4, and 7, the hinge elements are illustrated as perpendicular to the drawing page. Such Figures are reproduced below.